



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Davis et al.

Application No.: 09/679,261

Filed: October 4, 2000

For: PERIPHERAL DEVICE FOR A  
COMPUTER SYSTEM

Examiner: Regina Liang

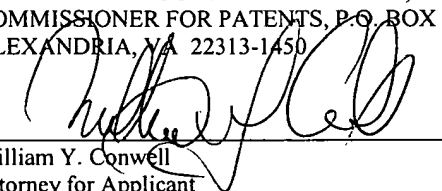
Date: June 5, 2003

Art Unit 2674

Confirmation No. 7123

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on June 5, 2003 as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF, COMMISSIONER FOR PATENTS, P.O. BOX 1450, ALEXANDRIA, VA 22313-1450

  
William Y. Conwell  
Attorney for Applicant

10/Reg for  
24  
PATENT ①  
Appeal  
Brief  
6-13-03  
NP  
C/m

APPEAL BRIEF

MAIL STOP APPEAL BRIEF  
COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, VA 22313-1450

RECEIVED

JUN 13 2003

Technology Center 2600

Sir:

This brief is in furtherance of the Notice of Appeal filed March 10, 2003. Applicants request a one month extension of time to file this Brief, from May 10 to June 10. Please charge the fees required under 37 CFR 1.17(f), and for the extension of time, and charge any other fee, to deposit account 50-1071 (see transmittal letter).

06/11/2003 CNGUYEN 00000048 501071 09679261

01 FC:1251 110.00 CH  
02 FC:1402 320.00 CH

I. REAL PARTY IN INTEREST .....	3
II. RELATED APPEALS AND INTERFERENCES.....	3
III. STATUS OF CLAIMS .....	3
IV. STATUS OF AMENDMENTS .....	3
V. SUMMARY OF THE INVENTION .....	3
VI. ISSUE.....	4
VII. GROUPING OF CLAIMS.....	4
VIII.DISCUSSION .....	4

**I. REAL PARTY IN INTEREST**

The real party in interest is Digimarc Corporation, by an assignment from the inventors recorded at Reel 011486, Frames 0807-8, on January 29, 2001.

**II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

**III. STATUS OF CLAIMS**

Claims 1-11 are finally rejected and appealed. A clean copy of the pending claims is attached to the end of this brief.

**IV. STATUS OF AMENDMENTS**

All amendments have been entered.

**V. SUMMARY OF THE INVENTION**

According to one aspect, Applicants' invention is a computer peripheral device that is adapted to fit in within a user's palm and slide over a medium (like a computer mouse), but equipped with an optical sensor and other circuitry, permitting it to acquire optically-encoded multi-bit information from the medium over which the device is placed.<sup>1</sup> The additional circuitry may include a decoder for discerning steganographically-encoded information represented in image data acquired by the optical sensor.<sup>2</sup>

According to another aspect, Applicants' invention is a method of interacting with printed material through use of a peripheral device having an optical sensing system. The method includes processing data from the optical sensing system to yield plural-bit data corresponding to machine-readable indicia on the printed material.<sup>3</sup> Again, steganographic decoding may be performed to yield the plural-bit data.<sup>4</sup>

---

<sup>1</sup> See, e.g., Specification, page 2, lines 4-7.

<sup>2</sup> See, e.g., Specification, page 2, lines 11-12.

<sup>3</sup> See, e.g., Specification, page 2, lines 17-23.

<sup>4</sup> See, e.g., Specification, page 2, line 23 ("Bedoop" is a reference to steganographic digital watermarks,

Such inventions find particular utility, e.g., in ordering merchandise from printed catalogs. The consumer places the device over a catalog page, and circuitry in the device extracts product information that is steganographically encoded (hidden) in the photo or other printing on the page. This information can then be sent to the merchant -- facilitating error-free ordering.

## **VI. ISSUE**

1. Did the Office err in refusing to consider a patent and other co-pending applications that were incorporated-by-reference, in considering whether the specification provides an enabling disclosure?

## **VII. GROUPING OF CLAIMS**

On the sole issue of the Examiner's failure to consider materials incorporated by reference, claims 1-11 stand or fall together.

## **VIII. DISCUSSION**

No art-based rejection has been raised as to any claim. The sole issue is enablement.

In response to the first Action rejecting claims on this ground, applicants' responded by observing that the allegedly lacking information is provided in patent documents incorporated by reference. In particular, reference was made to application 09/343,104, application 09/292,569, and patent 5,841,886.

The two applications are incorporated by reference at page 1, lines 8-10 of the specification, which states:

*The present disclosure memorializes certain improvements to the subject matter detailed in pending application 09/343,104 (June 29, 1999), and 09/292,569 (April 15, 1999), the disclosures of which are incorporated by reference.*

The '886 patent is incorporated by reference at page 3, lines 20-23, which states:

*Another use of the technology detailed in the '104 application (and other applications and patents of the present assignee, including patent 5,841,886 -- incorporated herein by reference) is to control building access (or facility access, or*

---

as detailed in incorporated-by-reference application 09/343,104.)

*room access, etc.) through a combination of an ID card, Bedoop technology, and proximity detection technology.*

The Examiner does not dispute that the referenced documents enable the claimed combinations. Rather, the Examiner maintains that incorporation by reference of such documents is not allowed:

*Applicants cannot incorporate all the subject matters into this application by referencing applications 09/341104 and 09/292569, and a patent 5,841,886 since it is not clear what subject matter from which application 09/343104 or 09/292569 or a patent 5,841,886 are being incorporate into present specification.<sup>5</sup>*

The Examiner continued:

*Also, since these applications were not incorporated by reference into the present application as filed, referencing these applications does not remedy the 35 U.S.C 112, first paragraph deficiencies.<sup>6</sup>*

Applicants respectfully submit that the Examiner is mistaken. *Ex parte Schwarze*, 151 USPQ 426 (Bd. App. 1966) is cited in MPEP 608.01(p) for the proposition that it is permissible to incorporate material by reference.<sup>7</sup>

The Examiner may require submission of a copy of the incorporated application. And if an incorporated application is still pending at the time the subject application is ready for issuance, the Examiner should require that any essential excerpts be bodily copied into the subject application. But the Examiner may not, as here, baldly refuse to consider incorporated-by-reference patent documents in considering enablement under Section 112.

Moreover, the Examiner has disregarded the familiar adage that a patent specification need not teach, *and preferably should omit*, subject matter that is familiar to artisans in the field. Thus, for example, the Examiner has faulted applicants for not detailing a “wireless link”<sup>8</sup> and “an optical sensing system comprising a 1D ... or 2D array.”<sup>9</sup> These, and the other elements cited in the rejection, are familiar to artisans working in the field. A detailed

---

<sup>5</sup> Final Action, text bridging pages 3-4.

<sup>6</sup> Final Action, page 4, lines 6-8.

<sup>7</sup> See also MPEP Section 2163.07(b).

<sup>8</sup> June 28, 2002 Action, page 4, lines 2-6.

<sup>9</sup> June 28, 2002 Action, page 4, paragraph ‘c.’

exposition of these elements would inappropriately lengthen the specification and burden the reader.

In view of the foregoing, the Examiner's Final Rejection is ill-founded, and should be reversed.

Date: June 5, 2003



23735

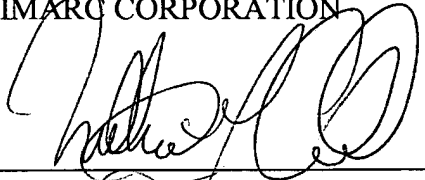
Phone: 503-885-9699

FAX 503-885-9880

Respectfully submitted,

DIGIMARC CORPORATION

By

  
William Y. Conwell

Registration No. 31,943

APPENDIX – PENDING CLAIMS

1. A peripheral device for use with a computer system comprising:  
a housing adapted to fit within a user's palm and slide over a medium;  
an optical sensor having plural sensing elements and producing image signals;  
a lens for imaging the medium onto the sensor;  
circuitry coupled to the sensor and disposed within the housing for processing the signals from the sensor and producing corresponding output data; and  
transfer means for relaying the output data from the peripheral device to the computer system;  
wherein said sensor is useful in acquiring optically-encoded multi-bit information from said medium for use by said computer system.
2. The device of claim 1 in which the transfer means is a cable.
3. The device of claim 1 in which the transfer means is a wireless link.
4. The device of claim 1 in which the circuitry analyzes the image signals and produces multi-bit information corresponding thereto.
5. The device of claim 1 in which the circuitry comprises a decoder for discerning steganographically-encoded information represented in said image signals.
6. The device of claim 1 in which the optical sensor comprises a 1D array of sensor elements.
7. The device of claim 1 in which the optical sensor comprises a 2D array of sensor elements.

8. A peripheral device for use with a computer system comprising:  
a housing adapted to fit within a user's palm and slide over a medium;  
an optical sensor having plural sensing elements and producing image signals;  
a lens for imaging the medium onto the sensor;  
circuitry coupled to the sensor and disposed within the housing for processing the signals from the sensor and producing corresponding output data; and  
transfer means for relaying the output data from the peripheral device to the computer system;

wherein said sensor is useful in acquiring optically-encoded multi-bit information from said medium for use by said computer system, and said circuitry is integrated on a common substrate with said sensing elements.

9. The method of claim 1 in which the optically encoded information comprises a plural-bit identifier.

10. A method of interacting with printed material using a peripheral device, the peripheral device providing positional data to an associated computer and including an optical sensing system comprising plural optical sensing elements, the method comprising:  
positioning the device over the printed material;  
generating optical sensor data from said optical sensing system, said data corresponding to a machine-readable indicia formed on the printed material;  
processing said optical sensor data to produce plural-bit data corresponding to said machine-readable indicia; and  
providing said plural-bit data to said computer.

11. The method of claim 10 which includes performing a steganographic decoding process on the optical sensor data to obtain said plural-bit data.